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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Franklin, et al.

Appeal No. _____

Serial No.: 09/676,445

Group Art Unit: 2628

Filed: 9/29/2000

Confirmation No.: 3483

Examiner: Jin Cheng Wang

For: **USE OF VECTOR GRAPHICS IN PAPER PRINTING AND WEBSITE DEVELOPMENT**

Commissioner for Patents

P. O. Box 1450

Alexandria, VA 22313-1450

Sir:

Second Revised Appeal Brief

In response to the Notice of Non-Compliant Appeal Brief mailed on July 25, 2006, enclosed is a Revised Appeal Brief including the Related Proceedings Appendix. This Appeal Brief is being transmitted in this application with respect to the Notice of Appeal filed on March 9, 2006. The Appeal Brief fee of \$250 was paid with the May 8, 2006 Appeal Brief mailing.

This brief contains these items under the following headings, and in the order set forth below:

1. Real Party in Interest	Page 2
2. Related Appeals and Interferences	Page 2
3. Status of the Claims	Page 2
4. Status of the Amendments	Page 2
5. Summary of Claimed Subject Matter	Page 3
6. Concise Statement of Each Ground of Rejection to be Reviewed on Appeal	Page 12
7. Arguments	Page 13
8. Conclusion	Page 22
9. Claims Appendix	Page 23
10. Evidence Appendix	Page 33
11. Related Proceedings Appendix	Page 33

1. Real Party in Interest

The real party in interest in this appeal is the assignee of all rights to the disclosed invention, 809, L.L.C., doing business as Furniture City Color.

2. Related Appeals and Interferences

There are no appeals or interferences that will directly affect or be directly affected by, or have a bearing on the Board's decision in this appeal.

3. Status of the Claims

Claims 1-22, and 24- 31 and 33 remain in the case with none of the claims being allowed or allowable. Claims 23 and 32 have been cancelled. Claims 1-22, and 24-31 and 33 are the subject of this appeal.

4. Status of the Amendments

No amendment after the final Office Action was submitted.

5. Summary of Claimed Subject Matter

The present invention relates to the conversion of vector graphics files to files suitable for display on an RGB color computer monitor that receives image data over the Internet. The invention is particularly well suited for producing electronic equivalents of retail catalogs printed on paper, wherein the electronic catalogs appear to be substantially identical to the retail catalogs printed on paper. Retailers can promote and sell merchandise such as furniture over the Internet using the electronic catalogs of the present invention. Moreover, the present invention can be used to provide an in-store reprint of selected catalog pages using an inexpensive RGB desktop printer.

Furniture manufacturers have for years generated very carefully planned and designed catalogs to aid in the promotion and sale of their products. Catalog design has become quite sophisticated, with particularized placement of text and graphics on the pages being chosen by the catalog designers to achieve specialized visual effects. Among the effects desired is the overlay of one photograph over a part of another. (Page 1, lines 11-16)

With the advent of the Internet and e-commerce endeavors, it is desired to replicate such catalogs on the Internet so that viewers and potential customers on the Internet will have identically the same image available to them as would be available in the printed catalog. Similarly, it may be desirable for many other types of print media to be transported to a browser-display with fidelity to the original. (Page 1, lines 17-22)

The state-of-the-art in printing, particularly with respect to catalogs, but for other printed products also, involves the use of digital electronics. The image to be printed is stored in an electronic file in a vector graphics format. In vector graphics, mathematical equations and file pointers are used to collate the text and images to be printed on the printed page. These files can

be processed to make the color separations needed in the printing process, according to known techniques. (Page 1, lines 23-28) The present invention adds a detour to the traditional prepress process by focusing on producing an Internet-ready electronic catalog, as distinguished from a hardcopy print catalog. Several technical issues must be solved to do this.

First, the size of the digital files for printed catalog pages, even using vector graphics, can be on the order of 25 million bytes, too large for transmission at reasonable speeds over commonly available digital networks. Also, among the 25 million bytes of information is much more detail than can typically be displayed on a monitor used in an Internet or other browser system. Typically, browsers display information in much less resolution, such as in the jpeg or gif format, having more on the order of 25,000 bytes of information, which can be reasonably quickly transmitted over digital networks. (Page 1, line 29 – page 2, line 2)

Second, the browsers display images according to instructions imbedded in a markup language, typically html. In html, code is written to determine the color, size, and placement of various items on a page, and such code is typically written or edited in a manual mode, although some page editor programs are now available. Nonetheless, creation of an html page or other markup language page to replicate with high fidelity the images of a printed catalog or other printed publication is very difficult and time consuming. Essentially, the html page must be prepared from scratch, requiring trial and error to determine how well the browser-displayed page replicates the printed page. Errors must be corrected by rewriting code. (Page 2, line 3-11)

The present invention provides a method of creating a web page from a vector graphics data file. Such a vector graphics file is typically the same type of file that is routed through a prepress operation. (Page 5, lines 23-32) The method includes a sequence of steps beginning with the conversion of the vector data file from its native file format to a bit map graphics file

format. (Page 6, lines 1-11) The vector graphics data file can be a prepress data file created using a software application program such as QuarkXPress, Adobe Illustrator, Macromedia Freehand, and etc. (Page 5, lines 32-34)

The bit map graphics file so made still cannot be displayed on a standard computer monitor, because standard computer monitors require RGB color values to properly display a color image and the paper print files use typically CMYK color space. As a result, a next step for converting the colors of the bit map graphics file is needed. In particular, the native color value settings must be converted to RGB color values. (Page 6, lines 12-22)

The next step in the sequence is the insertion of the color-modified bitmap into a web page to be displayed over the Internet. In some cases this step includes a further step of compressing the modified bitmap in order to make its Internet transfer faster. This compressing step can take place before or after the color conversion step. The compression can be accomplished by reducing the resolution of an image encoded in the file. Preferably, the file resulting from the compression conforms to an Internet format standard such as a joint photographic experts (jpeg) file or a graphics interchange format (gif) file. (Page 6, lines 23-30)

While the vector graphics data file of the present application is referred to as a prepress file in the beginning step of a preferred embodiment, this reference does not imply that the method of the present invention is a prepress process. In contrast, the disclosed method leads to the creation of an Internet web page that is a different result and follows a different path than traditional prepress processes.

Claim 1 defines the process as a method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file. The method comprises printing the catalog on paper from the vector graphics data file. (Page 3, line 32) (Although applicant's

claim recites this step first, this step does not have to occur first: it can follow on a parallel path with the other steps in the claim. Printing is usually the last thing that happens in the prior art cited by the Examiner.) The other steps recited in claim 1 are: converting the vector graphics data file from its native file format to a bit map graphics file format (Page 6, lines 1-11); modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values (Page 6, lines 12-22); inserting the modified bit map graphics data file into the electronic catalog web page (Page 6, lines 23-30); and making the electronic catalog web page available on the Internet for members of the public to view on a computer monitor (Page 8, lines 16-26) so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.

Independent claim 25 recites a method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file. It includes printing the catalog on paper from the vector graphics data file (Page 3, line 32); converting the vector graphics data file from its native file format to a bit map graphics file format (Page 6, lines 1-11); compressing the bitmap graphics file by reducing the resolution of an image encoded in the file to less than 100 dots per inch (dpi) by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values (Page 6, lines 23-30); modifying the bit-mapped graphics file; inserting the modified bit map graphics data file into the electronic catalog web page (Page 6, lines 23-30); and making the electronic catalog web page available on the Internet for the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog (Page 8, lines 16-26) and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.

Independent claim 26 recites a method of creating an electronic catalog web page and a catalog printed on paper from a composite file comprised of a vector graphics data file and an image file. The method includes printing the catalog on paper from the vector graphics data file (Page 3, line 32); converting the vector graphics data file from its native file format to a bit map graphics file format (Page 6, lines 1-11); modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values (Page 6, lines 23-30); inserting the modified bit map graphics data file into a web page template (Page 7, lines 15-23); generating the electronic catalog web page from the web page template (Page 7, lines 24 – page 8, line 19); and making the electronic catalog web page available on the Internet for the public to view on a computer monitor (Page 8, lines 16-26) so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file. (Desktop printers are inherent in many browser setups.)

Independent claim 27 recites a method for creating a plurality of electronic catalog web pages and a catalog printed on paper from a vector graphics data file. The plurality of web pages is substantially identical to a printed catalog publication rendered from the vector graphics data file. The method includes printing the catalog on paper from the vector graphics data file (Page 3, line 32); converting each of a plurality of pages of a printed publication rendered from the vector graphics data file from its native file format to a bit map graphics file format (Page 6, lines 1-11); modifying each of the plurality of the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values (Page 6, lines 12-22); inserting each of the plurality of the modified bit map graphics data file into an electronic catalog web page (Page 6, lines 23-30); and linking the plurality of electronic catalog

web pages such that the plurality of electronic catalog web pages are available on the Internet for the public to view on a computer monitor (Page 8, lines 1-11) so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB printer after the catalog has been printed on paper from the vector graphics data file.

Independent claim 28 recites a method of displaying a plurality of products on a website in connection with the offering for sale of the plurality of products. The method includes creating a vector graphics data file (Page 1, lines 23-25), wherein the vector graphics data file includes data capable of being converted to a press plate to create a catalog printed on paper (Page 3, line 32); printing the catalog on paper from the vector graphics data file (Page 3, line 32); deriving from the vector graphics data file an electronic catalog, wherein the electronic catalog appears to be substantially identical to the catalog printed on paper (Page 10, lines 5-12); and making the electronic catalog available for general viewing on browsers on computer monitors (Page 8, lines 1-11) so as to enable members of the public to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.

Independent claim 29 recites a method of displaying a plurality of products on a website in connection with the offering for sale of the plurality of products. The method includes the following steps in the sequence set forth:

1. creating a composite file comprised of a vector graphics data file and an image file, wherein the composite file is capable of being converted to a press plate for a catalog printed on paper; (Figure 1, step A)
2. printing the catalog on paper from the vector graphics data file; (Page 3, line 32)

3. deriving from the composite file an electronic catalog, wherein the electronic catalog appears to be substantially identical to the catalog printed on paper; and (Figure 1, steps B-L)

4. making the electronic catalog available for general viewing on browsers on computer monitors so as to enable members of the public to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file. (Figure 1, step M)

Independent claim 30 recites a method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file. The method includes printing the catalog on paper from the vector graphics data file (Page 3, line 32); converting the vector graphics data file from its native file format to a bit map graphics file format including both text and images (Page 6, lines 1-11); modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values (Page 6, lines 12-22); correcting text errors through the use of error correction routines to correct errors in the text that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format (Page 8, line 29 – page 10, line 2); and inserting the modified bit map graphics data file into a web page (Page 6, lines 23-30); and making the electronic catalog web page available on the Internet for the public to view on a computer monitor (Page 8, lines 16-26) so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after printing the catalog on paper from the vector graphics data file.

Independent claim 31 recites a method of displaying communication including printing a catalog on paper from a vector graphics data file (Page 3, line 32); displaying on a web browser

an electronic catalog web page made by creating the web page from a vector graphics data file (Page 8, lines 16-26). The method includes the following steps in the sequence set forth:

1. converting the vector graphics data file from its native file format to a bit map graphics file format including both text and images; (Page 6, lines 1-11)
2. modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values; (Page 6, lines 12-22)
3. inserting the modified bit map graphics data file into a web page (Page 6, lines 23-30); and
4. making the electronic catalog web page available on the Internet for the public to view on a computer monitor (Page 8, lines 16-26) so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after printing the catalog on paper from the vector graphics data file.

Independent claim 33 recites a method of creating a web page and a page printed on paper from a vector graphics data file. The method includes printing the page on paper from the vector graphics data file (Page 3, line 32); converting the vector graphics data file from its native file format to a bit map graphics file format (Page 6, lines 1-11); modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values (Page 6, lines 12-22); correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format. (Page 8, line 28 – Page 10, line 2) The error correction routines include:

- a) opening said modified bitmap graphics data file with a first drawing program running on a first computer; (Page 9, lines 1-12)

b) examining said modified bitmap graphics data file for text errors by visually comparing the raster image of said modified bitmap graphics data file to replicated printed material derived from said vector graphics file; (Page 9, lines 1-12)

c) closing and reopening said bitmap graphics data file with a different drawing program and/or different computer if text errors are found in step (b); (Page 8, lines 7-14)

d) repeating steps (b) and (c) until no errors are present in said modified bit map graphics file;

e) inserting the modified bit map graphics data file into the web page (Page 6, lines 23-30); and

f) making the web page available on the Internet for members of the public to view (Page 8, lines 16-26) after printing the catalog on paper from the vector graphics data file. (Page 3, line 32)

6. Concise Statement of Each Ground of Rejection to be Reviewed on Appeal

The following rejections are on appeal:

The examiner rejected claims 1-10, 14-22 and 24-31 and 33 under 35 U.S.C. § 103(a) as being directed to an invention that would have been obvious from the disclosure of U.S. Patent 6,429,947 to Laverty in view of the disclosure of U.S. Patent 6,611,348 to Chase, U.S. Patent 5,984,446 to Silverbrook, U.S. Patent 6,552,732 to Davis and U.S. Patent 5,389,044 to Aitkens.

The examiner rejected claims 11-13 under 35 U.S.C. § 103(a) as being directed to an invention that would have been obvious from the disclosure of Laverty in view of Chase and Aitkens in further view of U.S. Patent 5,956,737 to King et al.

7. Arguments -Applicable to each ground of rejection.

The examiner rejected claims 1-10, 14-22 and 24-31 and 33 as being obvious from the disclosure of U.S. Patent 6,429,947 to Laverty in view of the disclosure of U.S. Patent 6,611,348 to Chase and U.S. Patent 5,389,044 to Aitkens.

The basic issue on appeal is whether or not it would have been obvious to one of ordinary skill in the art to combine the elements of the Laverty, Chase and Aitkens references to obtain the combination of elements claimed by applicant. The examiner's Silverbrook, Davis and King references do not add the elements missing from this basic combination. This argument applied to all claims.

Laverty differs from applicant's invention in numerous ways

The Laverty invention is disclosed succinctly at his column 10, line 50 through column 11, line 38, discussing his Figure 3. The Laverty patent has its primary focus on preparing printed materials using CMYK printers of large volumes. Preparing the color separation files and the like is done electronically and can be shown to the customer who is commissioning the print job to verify his acceptance before the large volume paper printing job is completed. While that customer commissioning the print job may be viewing information over the Internet; that is inspection is over a private connection and is not one made available to the public. With its focus on the process of preparing large volumes of printed materials on CMYK printers, Laverty does not disclose, suggest or contemplate allowing members of the general public such as potential customers of items in a catalog to view the electronic catalog on the Internet and have identically the same image available to them on their computer screens as would be available in a printed catalog.

Laverty does not disclose making pages available to the Public

The Examiner asserted that Laverty discloses enabling members of the public to view over the Internet. In the case of Laverty, the Examiner points to the disclosure of making information available to system subscribers over the Internet. Laverty et al. only contemplates hosting a prepress application on a server, wherein an Internet front-end provides a **custom** web site for allowing an **individual** customer to proof a customer-specific prepress order. See Laverty et al. Col. 7, line 46 and Col. 10, lines 63-64. The pages are not generally available pages. That limited group of people is not the general public. The examiner takes the position that since the system subscribers are a subset of the general public, they are a species of the claimed genus and a disclosure of the species discloses the genus. This is a faulty application of the English language concepts of genus and species. Here, the presentation to the general public is a difference in the kind of presentation, not just in the number of folks who can view it.

Applicant's claim 1 recites "making the electronic catalog web page available on the Internet for members of the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer." The affirmatively recited element is the act of "making...available..." The general public is not being claimed as an element, but is mentioned as a way of indicating that the catalog does not need a password or other special privilege to access. The "public" as used in this syntax is to be interpreted as an integer, not subject to subdivision to look for species or subsets. Thus, contrary to the premise of the Examiner's rejection, Laverty et al does not disclose this feature.

Laverty does not disclose error correction routines to correct the text errors

The claimed invention, according to independent claims 1, 25- 27, and 30-31 include a recitation for a step of correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format. As such, for a cited reference to be anticipatory, the reference must describe this identical element. In other words, the reference, to teach in as much detail as is claimed by the present invention, must disclose a step of correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format.

The primary reference, Laverty et al. does not contain any teaching regarding a step of correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format.

Moreover, Laverty et al. actually teaches away from using **text error correction routines** by pointing out that the Print Ready File already has each element precisely mapped. Laverty goes on to say at column 8, lines 19-45: “Because no human is required to alter it, the data for the product and the location of its elements need not change.” In contrast, the present invention is more robust with regard to text elements, allowing a less-than-perfect vector file to BMP file conversion. As a result of this robustness, the present invention includes process steps that incorporate text error correction routines. On the other hand, Laverty teaches vector file to BMP file conversion without the use of text error correction routines. Therefore, one skilled in the art is **not** motivated to modify Laverty et al. to incorporate the steps that use the text error correction routines. Thus, there cannot be a *prima facie* case of obviousness with respect to the present invention.

Independent claim 28 includes steps of deriving from the vector graphics data file an electronic catalog, wherein the electronic catalog appears to be substantially identical to the catalog printed on paper; and making the electronic catalog available for viewing using a browser. Independent claim 29 includes steps of deriving from the composite file an electronic catalog, wherein the electronic catalog appears to be substantially identical to the catalog printed on paper; and making the electronic catalog available for viewing using a browser. While Laverty et al. mentions the term “catalogs-products-kits” as part of an on-line printing center database, there is no mention, teaching or suggestion the above-underlined recitations.

Applicant’s desktop printer is an RGB desktop printer, to make particularly clear that the printing being claimed at that stage is not the bulk CMYK printing that is the subject of the Laverty patent.

Chase differs from applicant’s invention in numerous ways

The Chase, et al. patent is similar to Laverty in focusing on preparing for CMYK printing. See, for example, column 1, lines 9-12 in which the Chase system is said to relate “generally to the field of publishing and printing, more particularly, the present invention relates to a system and method providing publishing and printing services via a communications network.”

Chase does not disclose making the pages available to the general public

The Examiner cites Fig. 2 of Chase as showing the availability of Chase’s images, but Fig. 2 shows to use a private network. The citation to column 11, lines 24-44 refer to “a client” -- not to the general public. The Examiner points to columns 16-20 as illustrating data

availability over the Internet, but the permitted users must first meet a profile, as pointed out at column 15, line 54 and column 16, line 27.

In column 5, lines 9-10, Chase says that a public network is a network of subscribers and non-subscribers. In an exemplary embodiment set forth by Chase, the public network is the Internet. The central service facility described by Chase is connected to the Internet via a firewall through which only subscribers are allowed access to a cached copy of their archived files. As a result of the firewall used by Chase, members of the general public are excluded from the publishing and printing services described by Chase. In contrast, the catalog of the present invention is available to the general public -- there is no firewall to exclude them. Therefore, Chase cannot be properly combined with Laverty to suggest that the present invention would have been obvious.

Neither Chase, et al. or Laverty is focused on making catalog web pages available on the Internet, particularly in a fashion of providing fidelity to printed materials separately being produced for CMYK printing.

Chase does not disclose using an RGB printer

The Examiner asserted that Chase teaches an RGB printer. However, column 7, line 52 of Chase teaches a black and white laser printer, item number 340 in the drawings. Moreover, column 7, line 54 describes a color proofer item number 330 in the drawings. Color proofer 340 is not an RGB printer -- Chase describes it as a 4-color machine (i.e. CMYK, rather than RGB). Furthermore, column 11, lines 60-63 of Chase mentions that a printing facility receives digital RGB images, but fails to suggest printing the RGB images on an RGB printer. Instead, Chase converts the RGB images to CMYK color space for printing on a CMYK printer.

Finally, neither Chase et al., nor Laverty, has any disclosure or suggestion to make the images remotely available to the public on the Internet for viewing on a monitor and printing on RGB printers.

Aitkens differs in numerous ways

The examiner points to column 7 of Aitkens as saying that RGB printers are known. Accepting that premise (despite the fact that Aitkens uses the RGB printer in a very unconventional way, to print in reverse on transparent vinyl laminate (column 7, line12-16) at 75% to 85% density (column 7, lines 36-37), one of ordinary skill in the art still would not have found it obvious to use such a printer with Laverty or Chase.

Of course, Aitkens does nothing to fill in the gaps of the primary references as to making web pages available to the general public or using error correction routines to correct the text errors.

These features

--Public availability over the internet

--RGB printing

--Text error correction

are clearly outlined in the claims, and therefore the claims differentiate from the cited references in a patentable fashion. Not only are the claims not anticipated, there is no motivation or suggestion to modify the prior art to reach the subject matter of Applicant's claims, so that it is not proper to say that the claimed invention would have been obvious from Laverty or Chase et al. or Aitkens either.

The Examiner cites Silverbrook as disclosing printing catalogs and the conversion of vector graphics files to print files. Silverbrook's main emphasis is on providing a single printer that can serve for low volume and high volume demands (see column 32). It has no disclosure or suggestion of making pages available over the internet for printing by a wholly separate desktop printer in RGB format.

The Examiner cites Davis et al. for the proposition that a vector graphics application creates a vector graphics file, citing Davis column 6. Applicant agrees that such applications may create vector graphics files, but fails to see how that observation has any bearing on the patentability of the claimed invention.

Davis is also mentioned in the rejection as disclosing printing a catalog. This is factual error. The only catalog mentioned in Davis is discussed at column 6 lines 21-28 as: "The vector graphics catalog 34 may comprise a series of vector objects 76 previously generated by the vector graphics application 32. As previously described for vector objects 56, the vector objects 76 may include data, properties and an active area. Accordingly, the vector graphics catalog 34 allows vector objects 76 to be created and stored along with their properties for later use in generating Web pages." Thus, the catalog is a file within the software that "catalogs" the vector objects available for use – far from the catalog printed on paper of the claims.

Perhaps most curious is how Davis could ever be cited as being pertinent to applicant's invention that uses vector graphics for the paper printing and a bit map graphics data file for the electronic catalog web page. Davis is all about using vector graphics over the internet, not bit map files. At column 1, line 19-30, Davis teaches away from using bit map files on the internet.

A prima facie case of obviousness is established when the teachings of the prior art suggests the claimed invention. But, the mere fact that the prior art itself may be modified does

not make the modification *prima facie* obvious unless the prior art suggests the desirability of the modification. See, e.g., MPEP §2142 and 2143.01. Thus, the references must expressly or impliedly suggest the claimed invention. Furthermore, the August 2, 2001 Federal Circuit decision in *In Re Zurko*, 59 USPQ 2d 1693 (Fed. Cir. 2001) holds that deficiencies of cited references cannot be remedied by general conclusions about what is “basic knowledge” or “common sense” to one of ordinary skill in the art.

The Examiner has pointed to several references that merely contain parts that the examiner alleges may be used in the present invention, without stating a motivation that those references provide to one of ordinary skill in the art to combine those parts. A lawful holding of obviousness based on a combination of references requires some teaching or suggestion in the references that would lead one skilled in the art to combine the references in a way that would result in the applicant's claimed invention. *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant). *In re Dembicza*k, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (“Our case law makes clear that the best defense against **the subtle but powerful attraction of a hindsight-based** obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” (emphasis added)). As stated in *In Re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000): “particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”.)

In the discussion at page 3, third full paragraph and paragraph bridging pages 3 and 4 of the Final Rejection, the Examiner paid lip service to the requirement for motivation. (These

paragraphs were apparently block-copied to several other pages of the Final Rejection, too.)

However, those alleged motivations amount to nothing more than, “because reference A teaches X and reference B teaches Y, the combination of X and Y as claimed is obvious.” That is exactly what the Federal Circuit says is improper.

Regarding Claim 30 and new Claim 33, the cited Laverty et al. patent and cited U.S. Patent No. 5,956,737 to King et al. both describe method steps that include raster image processing. The claims of the present application also describe method steps that include raster image processing. However, the applicant’s method steps as currently specifically claimed, incorporate a step of correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format. Neither Laverty et al. nor King et al. mention, teach or suggest the above step.

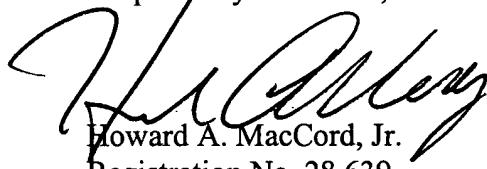
Moreover, Laverty et al. actually teaches away from using **text error correction routines** by pointing out that the Print Ready File already has each element precisely mapped. Laverty goes on to say: “Because no human is required to alter it, the data for the product and the location of its elements need not change. (Please see column 8, lines 19-45.) In contrast, the present invention is more robust with regard to text elements, allowing a less than perfect vector file to BMP file conversion. As a result of this robustness, the present invention includes process steps that incorporate text error correction routines. On the other hand, Laverty teaches vector file to BMP file conversion without the use of text error correction routines. Therefore, one skilled in the art is **not** motivated to modify Laverty et al. to incorporate the steps that use the

text error correction routines. Thus, there cannot be a *prima facie* case of obviousness with respect to the present invention.

8. Conclusion

The Examiner's rejection of Claims 1-22, 24-31 and 33 should be reversed.

Respectfully submitted,



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Date: August 25, 2006

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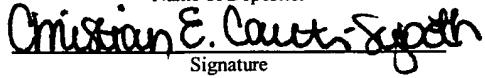
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25 AUGUST 2006

Date of Signature

9. Claims Appendix

The appealed claims are as follows:

1. A method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file comprising

 - printing the catalog on paper from the vector graphics data file;
 - converting the vector graphics data file from its native file format to a bit map graphics file format;
 - modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values;
 - inserting the modified bit map graphics data file into the electronic catalog web page; and
 - making the electronic catalog web page available on the Internet for members of the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.
2. The method of claim 1, wherein the method is further comprised of compressing the modified bitmap graphics data file prior to inserting.
3. The method of claim 2, wherein compressing precedes modifying.
4. The method of claim 2, wherein the bit map graphics file is compressed by reducing the resolution of an image encoded in the file to less than 100 dots per inch (dpi).

5. The method of claim 4, wherein the bit map graphics file is compressed by reducing the resolution of an image encoded in the file to about 72 dpi.
6. The method of claim 2, wherein the bit map graphics file is compressed by converting the bit map graphics file to a joint photographic experts (jpeg) file.
7. The method of claim 6, wherein the bit map graphics file is converted to a jpeg file by opening the bit map graphics file in a paint program and exporting the bit map graphics file to a jpeg file format.
8. The method of claim 2, wherein the bit mapped graphics file is compressed by converting the bit mapped graphics file to a graphics interchange format (gif) file.
9. The method of claim 2, wherein the bit mapped graphics file is compressed by converting the bit mapped graphics file to a tagged image file (tif) format file.
10. The method of claim 2, wherein the bit mapped graphics file is compressed by converting the bit mapped graphics file to an X bitmap (xbm) file.
11. The method of claim 2, wherein the compressed and modified bit map graphics data file is inserted into the web page by tagging the file as an inline image.

12. The method of claim 11, wherein the inline image is a link to a higher resolution version of an image that is substantially the same as the inline image.

13. The method of claim 2, wherein the compressed and modified bit map graphics data file is inserted into the web page by tagging the file as an external image.

14. The method of claim 1, wherein modifying precedes converting.

15. The method of claim 1, wherein the vector graphics data file is a prepress data file.

16. The method of claim 15, wherein the prepress datafile is created using a software application program selected from the group consisting of QuarkXPress, Adobe Illustrator, Macromedia Freehand, Adobe PageMaker, Corel Draw and Adobe Acrobat.

17. The method of claim 1, wherein the web page is a markup language file.

18. The method of claim 17, wherein the markup language is selected from the group consisting of hypertext markup language (html), extensible markup language (xml), Cold Fusion markup language (cfml), commerce markup language xml (cxml), handheld device markup language (hdml), standard generalized markup language (sgml), synchronized multimedia integration language (smil), extensible hypertext markup language (xhtml), extensible style language (xsl), and wireless markup language (wml).

19. The method of claim 1, wherein the bit map graphics file is an encapsulated post script (eps) file.

20. The method of claim 19, wherein the eps file, when rendered, is an 8.5" by 11" image.

21. The method of claim 1, wherein the vector graphics data file is a prepress data file, the bit map graphics file is an encapsulated post script (eps) file, and the prepress data file is converted to an eps file by exporting the prepress data file in its native file format to an eps format.

22. The method of claim 1, wherein the vector graphics data file is a prepress data file, the bit map graphics file is in a tagged image file format (tif), and the prepress data file is converted to a tif file by exporting the prepress data file in its native file format to an tif format.

24. The method of claim 1, wherein the CMYK color values are converted to RGB color values using a paint program.

25. A method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file comprising

printing the catalog on paper from the vector graphics data file;

converting the vector graphics data file from its native file format to a bit map graphics file format;

compressing the bitmap graphics file by reducing the resolution of an image encoded in the file to less than 100 dots per inch (dpi) by converting cyan, magenta, yellow, black (CMYK)

color values to red, green, blue (RGB) color values;
modifying the bit-mapped graphics file;
inserting the modified bit map graphics data file into the electronic catalog web page; and
making the electronic catalog web page available on the Internet for the public to view on
a computer monitor so as to select one or more pages of interest from the electronic catalog and
print selected pages on an RGB desktop printer after the catalog has been printed on paper from
the vector graphics data file.

26. A method of creating an electronic catalog web page and a catalog printed on paper from a composite file comprised of vector graphics data file and an image file, the method comprising
printing the catalog on paper from the vector graphics data file;
converting the vector graphics data file from its native file format to a bit map graphics
file format;
modifying the bitmap graphics data file by converting cyan, magenta, yellow, black
(CMYK) color values to red, green, blue (RGB) color values;
inserting the modified bit map graphics data file into a web page template;
generating the electronic catalog web page from the web page template; and
making the electronic catalog web page available on the Internet for the public to view on
a computer monitor so as to select one or more pages of interest from the electronic catalog and
print selected pages on an RGB desktop printer after the catalog has been printed on paper from
the vector graphics data file.

27. A method for creating a plurality of electronic catalog web pages and a catalog printed on

paper from a vector graphics data file, wherein the plurality of web pages is substantially identical to a printed catalog publication rendered from the vector graphics data file comprising

printing the catalog on paper from the vector graphics data file;

converting each of a plurality of pages of a printed publication rendered from the vector graphics data file from its native file format to a bit map graphics file format;

modifying each of the plurality of the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values;

inserting each of the plurality of the modified bit map graphics data file into an electronic catalog web page; and

linking the plurality of electronic catalog web pages such that the plurality of electronic catalog web pages are available on the Internet for the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB printer after the catalog has been printed on paper from the vector graphics data file.

28. A method of displaying a plurality of products on a website in connection with the offering for sale of the plurality of products, the method comprising

creating a vector graphics data file, wherein the vector graphics data file includes data capable of being converted to a press plate to create a catalog printed on paper;

printing the catalog on paper from the vector graphics data file;

deriving from the vector graphics data file an electronic catalog, wherein the electronic catalog appears to be substantially identical to the catalog printed on paper; and

making the electronic catalog available for general viewing on browsers on computer monitors so as to enable members of the public to select one or more pages of interest from the

electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.

29. A method of displaying a plurality of products on a website in connection with the offering for sale of the plurality of products, the method comprising the following steps in the sequence set forth:

creating a composite file comprised of a vector graphics data file and an image file, wherein the composite file is capable of being converted to a press plate for a catalog printed on paper;

printing the catalog on paper from the vector graphics data file;

deriving from the composite file an electronic catalog, wherein the electronic catalog appears to be substantially identical to the catalog printed on paper; and

making the electronic catalog available for general viewing on browsers on computer monitors so as to enable members of the public to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after the catalog has been printed on paper from the vector graphics data file.

30. A method of creating an electronic catalog web page and a catalog printed on paper from a vector graphics data file comprising

printing the catalog on paper from the vector graphics data file;

converting the vector graphics data file from its native file format to a bit map graphics file format including both text and images;

modifying the bitmap graphics data file by converting cyan, magenta, yellow, black

(CMYK) color values to red, green, blue (RGB) color values; correcting text errors through the use of error correction routines to correct errors in the text that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format; and inserting the modified bit map graphics data file into a web page; and making the electronic catalog web page available on the Internet for the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after printing the catalog on paper from the vector graphics data file.

31. A method of displaying communication comprising:

printing a catalog on paper from a vector graphics data file; displaying on a web browser an electronic catalog web page made by creating the web page from a vector graphics data file, including the following steps in the sequence set forth: converting the vector graphics data file from its native file format to a bit map graphics file format including both text and images; modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values; inserting the modified bit map graphics data file into a web page; and making the electronic catalog web page available on the Internet for the public to view on a computer monitor so as to select one or more pages of interest from the electronic catalog and print selected pages on an RGB desktop printer after printing the catalog on paper from the vector graphics data file.

33. A method of creating a web page and a page printed on paper from a vector graphics data file comprising

printing the page on paper from the vector graphics data file;

converting the vector graphics data file from its native file format to a bit map graphics file format;

modifying the bitmap graphics data file by converting cyan, magenta, yellow, black (CMYK) color values to red, green, blue (RGB) color values;

correcting text errors through the use of error correction routines to correct the text errors that occur when the vector graphics data file was converted from its native file format to a bit map graphics file format, said error correction routines comprising of:

a) opening said modified bitmap graphics data file with a first drawing program running on a first computer;

b) examining said modified bitmap graphics data file for text errors by visually comparing the raster image of said modified bitmap graphics data file to replicated printed material derived from said vector graphics file;

c) closing and reopening said bitmap graphics data file with a different drawing program and/or different computer if text errors are found in step (b);

d) repeating steps (b) and (c) until no errors are present in said modified bit map graphics file;

e) inserting the modified bit map graphics data file into the web page; and

f) making the web page available on the Internet for members of the public to view after printing the catalog on paper from the vector graphics data file.

10. Evidence Appendix

These references were cited by the Examiner in making rejections, and applicant relies on portion of them to show the errors of the rejections. Copies are attached.

Patent Number	1st Named Inventor	Examiner Cited in Office Action Dated
US 6,429,947	Laverty, et al.	June 16, 2003
US 5,956,737	King, et al.	December 5, 2002
US 6,611,348	Chase, et al.	December 10, 2003
US 5,984,446	Silverbrook	December 6, 2005
US 6,552,732	Davis, Jr., et al.	January 11, 2005
US 5,389,049	Aitkens, et al.	December 6, 2005

11. Related Proceedings Appendix

None.